UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,717	11/21/2001	Victor Wiener	101351-21	1000

21125	7590	02/10/2006

NUTTER MCCLENNEN & FISH LLP
WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON, MA 02210-2604

EXAMINER
ELAHEE, MD S

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/990,717	WIENER ET AL.
	Examiner	Art Unit	
	Md S. Elahee	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2005*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *40-89* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *40-89* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 40-41,45-46,50-51,56-57,60-61,69-70, 73,77, rejected under 35 U.S.C. 102(b) as

being clearly anticipated by **Padden et al.** (US 4,979,206).

As to Claims 40-41,45-46,56-57,69-70, with respect to Figures 1-6, **Padden** teaches a method of

establishing a communications call, including:

enabling an A party to select a target customer (a B party) from a database of a messaging

network using a VRU (an interactive device) connected to a public network, said public network

comprising a messaging network (Figure 1 and Col. 6, lines 49-60);.

utilizing said messaging network to access called address data for said B party from a

public directory of said public network in response to selecting said B party (Col. 6, lines 60-67

and Col. 7, lines 1-7);

sending said called address data for said B party and calling address data for the caller (the

A party) to control 10 (a connection module) of said public network (Col. 7, lines 3-15); and

establishing a call between said A and B parties over said public network using said connection module and said called and calling address data (Col. 7, lines 11-14).

As to Claims 50-51,60-61,73,77 are rejected for the same reasons as discussed above with respect to claim 40. Furthermore, with respect to Figures 1-6, **Padden** teaches an interactive device for originating a communications call, including:

a display controller for causing display of a desired directory number (at least one B party) (Col. 5, lines 14-18);

an operator (selector) for enabling an A party to select a B party on said display (Col. 5, lines 20-30); and

data link 54 (a link) which on being activated sends selected party data corresponding to said B party to a DAS/C computer (public network),

whereby said public network accesses called address data of said B party in a public directory via a messaging network on the basis of said selected party data and forwards said called address data to connection module of said public network to establish a call with said B party (Col. 5, lines 50-68).

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 60, 62/60, 64/60, 65/60,66/60, 67/60, 68, rejected under 35 U.S.C. 102(e) as

being anticipated by **Bateman et al.** (US 5,884,032).

As to Claim 60, with respect to Figures 1-3, **Bateman** teaches a system for use in establishing a

communications call, including:

a public directory accessible via an internet (messaging network) including called address

data for parties connected to at least one public network (Figure 1 and Col. 6, lines 6-13,31-45,

Col. 9, lines 19-32);

an access module for transmitting said called address data for display on an interactive

device, and for utilizing the messaging network to receive selected party data from said

interactive device to enable an A party to select a B party (Col. 6, lines 31-45, Col. 8, lines 66,67,

Col.9, lines 1-32);

a controller for receiving said selected party data, including called address data for the

selected B party, and calling address data corresponding to the customer (an A party) and

generating, in response thereto, network control signals to cause said at least one public network

to establish a call between said A party and said B party over said network (Col. 6, lines 32-41,

Col. 7, lines 5-13, Col. 9, lines 65-67, Col.10, lines 1-13).

As to Claim 62/60, **Bateman** teaches a system as claimed in claim 60 or 61, wherein said

network includes at least one public telecommunications network, such as a PSTN, for receiving

said control signals and establishing said call, and wherein the messaging network comprises the

Internet, for passing data between the A party, the access module and the network controller (Figures 1,5).

As to Claims 64/60, **Bateman** teaches a system as claimed in claims 60 or 61, including a search module accessible by said A party over said network for searching said directory database (Col. 6, lines 1-5).

As to Claims 65/60, **Bateman** teaches a system as claimed in claims 60 or 61, wherein said call is established with a terminal of the A party which selects said selected B party (Col. 6, lines 1-5).

As to Claims 66/60, **Bateman** teaches a system as claimed in claims 60 or 61, wherein said call is established with a terminal of the A party which is separate from the terminal selecting said B party (Figure 1, label 2).

As to Claims 67/60, **Bateman** teaches a system as claimed in claims 60 or 61, wherein the address data includes a party terminal number and security information (Col. 6, lines 44-50).

As to Claim 68, **Bateman** teaches a system as claimed in claim 60, wherein at least one of the calling address data and the called address data includes account information (Col. 6, lines 63-60 and 6-8).

Claim Rejections - 35 USC § 103

5.   · The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

7.   This application currently names joint inventors.   In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8.   Claims 40, 41, 42/40,42/41, 43-46, 47/40,47/41,47/45, 47/46, 48-52, 53/50,53/51,53/52,

54-58, 59/56,59/57, 60-61, 62/60,62/61, 63, 64/60,64/61, 65/60,66/61, 67/60,67/61, 68-71,

72/69,72/70, 73-87, 88/40,88/41,88/45,88/46,88/73, 89/40,89/41,89/45,89/46,89/73 are rejected

under 35 U.S.C. 103(a) as being unpatentable over **Bateman et al**. (US 5,884,032) in view of

Padden et al. (US 4,979,206).

As to Claims 40,45-46,50-51,60,70,73,79-87, with respect to Figures 1-3, **Bateman** teaches a

method of establishing a communications call, including:

enabling a customer (an A-party) to select on-line help agent (a B party) using an

interactive device, 4, connected to a public network, 6 and 9, said public network comprising the

Internet (messaging network) (Figure 1 and Col. 6, lines 6-13);

utilizing said messaging network to access web pages (called address data) for said B

party from a public directory, 52, of said public network, 6, in response to selecting said B party

(Col. 6, lines 31-45);

sending said called address data for said B party and calling address data for the customer

(an A party) to an ACD-MIS system (connection module) of said public network (Col. 6, lines

32-41); and

establishing a call between said A and B parties over said public network using said

connection module and said called and calling address data (Col. 7, lines 5-13).

Bateman teaches when a customer selects a "HELP" button, ACD functionality distributes a call

corresponding to the selection to one of a plurality of agents (col.9, lines 65-67, col.10, lines 1-

13, 31-38). However, **Bateman** does not specifically teach selecting a B party from a database of

a messaging network. **Padden** teaches selecting a B party from a database of a messaging

network (abstract; Col. 6, lines 49-67 and Col. 7, lines 1-7). Thus, it would have been obvious to

one of ordinary skill in the art at the time the invention was made to modify **Bateman** to select a

B party from a database of a messaging network as taught by **Padden**. The motivation for the modification is to have doing so in order to make a search of a directory to get an available agent instead of waiting for a certain period of time in a queue.

As to Claims 41,61,69 are rejected for the same reasons as discussed above with respect to claim 40. Furthermore, **Bateman** teaches a method of establishing a communications call, including:

enabling an A party to select a B party using an interactive device connected to a public network, said public network comprising a messaging network (Figure 1 and Col. 6, lines 6-13);

utilizing said messaging network to access called address data for said B party using said interactive device and a search module of said public network and a database of said public network including called address data (Col. 6, lines 31-45);

sending said called address data for said B party and calling address data for the A party to a connection module of said public network (Col. 6, lines 32-41); and

establishing a call between said A and B parties over said public network using said connection module and said called and calling address data (Col. 7, lines 5-13).

As to Claim 42/40, 42/41, **Bateman** teaches a method as claimed in claims 40 or 41, wherein said interactive device is a computer and/or telephony device including a visual display (Figure 1, label 4).

As to Claim 43, **Bateman** teaches a method as claimed in claim 40, wherein said interactive device is associated with said A party (Figure 1).

As to Claim 44, **Bateman** teaches a method as claimed in claim 40, wherein said interactive device is a communications terminal for said call (Col. 7, lines 5-13).

As to Claims 47/45, 47/46, **Bateman** teaches a method as claimed in claims 45 or 46, wherein said public network further comprises at least one public telecommunications network, 9, for connecting said A and B parties (Figure 1).

As to Claim 48, **Bateman** teaches a method as claimed in claim 47, wherein said messaging network provides said interactive device with a plurality of B party data (Col. 6, lines 32-45).

As to Claim 49, **Bateman** teaches a method as claimed in claim 47, wherein said messaging network accesses and forwards said called address data to said telecommunications network (Col. 6, lines 31-45).

As to Claims 52,58, **Bateman** teaches an interface as claimed in claim 51, wherein said results includes called address data for said B party data, and said selected party data includes said called address data (Col. 6, lines 31-41).

As to Claims 53/50,53/51, **Bateman** teaches an interface as claimed in claims 50, 51 or 52, wherein said interface is sent to said interactive device by said public network on request from said interactive device (Col. 6, lines 1-20).

As to Claims 54-55, **Bateman** teaches an interface as claimed in claim 51, wherein said public network further comprises at least one public telecommunications network for establishing said call (Figure 1).

As to Claims 56-57,77, with respect to Figure 1, **Bateman** teaches an interface stored on an interactive device connected to a public network, including:

code for generating a display on interactive device of B party data (Col. 6, lines 8-20);

code allowing an A party to select a B party from said B party data (Col. 6, lines 20-30); and

code for transmitting to said public network selected party data corresponding to the selected B party and A party data (Col. 6, lines 25-30);

whereby said public network accesses called address data for said B party in a public directory of a messaging network of said public network on the basis of said selected party data and establishes a call between an A party and a B party using said A party data and said called address data (Col. 6, lines 31-55).

As to Claims 59/56,59/57, **Bateman** teaches an interface as claimed in claims 56 or 57, wherein said messaging network of the public network includes a TCP/IP messaging network and said public network further comprises at least one public switched telephone network for establishing said call (Figure 1).

As to Claim 63, **Bateman** teaches a system as claimed in claim 61, wherein the access module includes directory data from said directory database for display by said A party (Col. 6, lines 32-41).

As to Claims 62/61,64/61,65/61,66/61,67/61 are rejected for the same reasons as discussed above with respect to claims 62/60, 64/60,65/60,66/60,67/60 simultaneously.

As to Claim 68, **Bateman** teaches a system as claimed in claim 60, wherein at least one of the calling address data and the called address data includes account information (Col. 6, lines 63-60 and 6-8).

As to claim 71, **Bateman** teaches a server as claimed in claim 70, including a directory database module for accessing directory data, including communications address data, of parties connected to at least said public network, wherein the communications address data of said connect message for at least said B party is obtained using said directory database module (Col. 7, lines 43-61).

As to Claims 74,78, **Bateman** teaches a method as claimed in claim 73, wherein the identification data is page (name data) (Col. 5, lines 15-22).

As to Claim 75, **Bateman** teaches a method as claimed in claim 73, wherein the directory service is adapted to access a database of URLs (public communications addresses) stored against respective identification data (Col. 5, lines 15-22).

As to Claim 76, **Bateman** teaches a method as claimed in claim 73, wherein selection of the displayed element invokes generation of code on the interactive device to generate and send the first message (Col. 6, lines 14-24).

As to Claims 88/40,88/41,88/45,88/46,88/73, **Bateman** teaches a network system having components for executing the steps of a method as claimed in claims 40, 41, 45, 46, 73 (Col. 6, lines 31-60).

As to Claims 89/40,89/41,89/45,89/46,89/73, **Bateman** teaches a Computer software having code for executing the steps of a method as claimed in claims 40, 41, 45, 46, 73 (Col. 6, lines 14-65).

Response to Arguments

9.   Applicant's arguments filed in the 11/21/05 Remarks have been fully considered but they are not persuasive because of the following:

    (a) **Bateman:**

Applicant's arguments with respect to claims 40-59,61,62/61, 64/61,65/61,66/61,67/61 and 69-89 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 60, 62/60, 64/60, 65/60,66/60, 67/60, 68 have been considered but they are not persuasive. The applicant didn't claim "enabling an A party to select a B party from a database of a messaging network".

(b) **Padden** does not teach the customer is not enabled to select a party for which a directory number is desired from a database of a messaging network. Rather, the customer utilizes a speech recognition unit of the system to identify a desired directory number.

Examiner respectfully disagrees. A customer is prompted to speak commands for identifying a requested directory number for a target customer from a list of directory numbers (see Col.5, lines 57-63, Col.6, lines 49-68, col.7, lines 1-7). Therefore, it is clear that the customer is enabled to make a selection for the target customer. Thus the rejections in view of **Padden** remains.

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
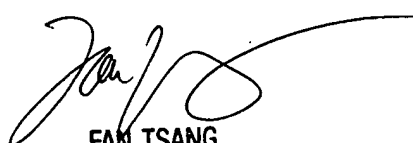
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M.E.

MD SHAFIUL ALAM ELAHEE
February 4, 2006

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600